

Appl. No. : 09/631,576
Filed : August 4, 2000

REMARKS

Claims 80-81 have been added. Claims 60, 69, and 77-79 have been amended. As a result of the Amendments, Claims 40, 51-72, 74, 75, and 77-81 are presented for further examination. Support for the language added to the Specification and Claims 77-79 specifying that the cleats "extend generally in the plane of the optic/haptic", can be found in the Figures as filed, for example Figures 2A-2C. Applicants would like the Examiner to note that as stated in MPEP §2163.06 the "information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter." The description of the cleats as generally extending in the plane of the haptic does no more than describe what is in Figures 2A-2C as filed.

Support for added claims 80-81 can be found in the Specification and claims as filed, for example, page 5, paragraph 33 and Figures 2A, 4C, 5G and 5H. The changes made to the Specification and Claims by the current amendment, including ~~deletions~~ and additions, are shown herein with deletions designated with a strikethrough and additions underlined. No new matter has been added herewith.

Rejection under 35 U.S.C. §112, second paragraph

Claims 60 and 69 were rejected as being indefinite for the following reasons:

Claim 60 depends upon itself. Thus, claim 60 has been amended to depend upon Claim 59. Claim 69 lacks antecedent basis for the phrase "said hinge". Thus, claims 69 has been amended to depend upon Claim 53, which does provide antecedent basis.

Rejection under 35 U.S.C. §102(b)

The Examiner believed Claims 78 and 79 to be anticipated by Benjamin (FR 2,728,459).

However, to be anticipatory under 35 U.S.C. § 102, a reference must teach each and every element of the claimed invention. *See Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986). "Invalidity for anticipation requires that all of the elements and limitations of the claim are found within a single prior art reference. There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991).

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Claims 78 and 79 recite an IOL comprising: an optic with at least two cleats, and a haptic with at least two eyelets, wherein the cleats on the optic extend generally in the plane of the optic.

Benjamin et al. teaches in Figure 15 cleat-like projections (47) in the form of mushrooms (projection 45/stem 46 on Figure 15) on the optic. These cleat-like projections clearly do not “extend generally in the plane of the optic” because the projection 45 clearly projects outwardly from the plane of the optic at a 90° angle.

Thus, Benjamin et al does not anticipate the invention because it does not provide that the cleats “extend generally in the plane of the optic”.

Rejection under 35 U.S.C. §103(a)

The Examiner believed that Claims 40, 51-53, 56, 67, 68, 74 and 79 were unpatentable over Benjamin (FR 2,728,459)

The law is clear that three basic criteria must be met to establish a *prima facie* case of obviousness: (MPEP ¶2143):

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references, when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure (*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1440 (Fed. Cir. 1991)).

Claims 40 and 79 generally recite an IOL comprising: an optic with at least two eyelets, and a haptic with at least two cleats. Further, Claim 79 additionally recites that: the cleats on the haptic extend generally in the plane of the haptic. Whereas Claim 40 additionally recites that: the haptic is more rigid than the optic.

Benjamin et al. teaches in Figure 15 cleat-like projections (47) in the form of mushrooms (projection 45/stem 46 on Figure 15) which are found on the optic.

With reference to independent Claim 40, Benjamin et al. does not teach all of the claim elements because it does not teach that the cleats are on the haptic. Further it would not have been “a mere reversal of the essential working parts of a device involve [ing] only routine skill in the art” to move the cleats to the haptic because the materials are different for the claimed IOL.

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The IOL as presently claimed herein, teaches a more rigid haptic with more rigid cleats (see the language in the claim stating that the haptic is more rigid than the optic"). Thus, the eyelet, which is found on the optic, is of a more flexible material. This allows the surgeon to stretch the eyelet much like a rubber band to more easily position it upon the cleat within the eye (Please see Figures 5G-H and 8E, for example and the description on page 9, paragraph 41 in the Specification as filed). This clearly makes the IOL as claimed in Claim 40 surprisingly effective for use within the eye and for surgical purposes. Thus, it would not a mere reversal of the essential working parts of the invention to place the cleats on the haptic and Applicants respectfully request withdrawal of the rejection under 35 USC §103.

With reference to Independent Claim 79, Benjamin et al. does not teach all of the claim elements because it does not teach that the cleats are on the haptic. Further it does not teach that the cleats extend generally in the plane of the haptic as taught in the presently amended Claim 79. Benjamin teaches only the mushroom-shaped projections shown in figure 15. These mushroom-shaped projections clearly do not "extend generally in the plane of the haptic", because the projection 45 projects outwardly from the plane of the optic at a 90° angle. A right angle is as far from "generally in the plane of the haptic" as it is possible to get.

Applicants would like to note that the Dependent claims are further patentable in view of Benjamin et al. as being dependent upon a patentable claim as well as incorporating further limitations. Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. §103.

Conclusion

In view of the remarks herein, it is believed that the claims are allowable. However, should the Examiner have any further questions, please contact the undersigned at the telephone number appearing below.

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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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